

**REMARKS**

In the Final Office Action, the Examiner rejected claims 1, 4, 6, and 31, and allowed claim 27. Further, the Examiner objected to claim 2 for depending from a rejected base claim, but indicated that this claim contains allowable subject matter. Applicants canceled claims 3, 5, 7-26, and 28-30 in previous communications. Applicants thank the Examiner for the recognition of allowable subject matter in the present claims. By the present Response, Applicants amend claims 1 and 31 to further clarify the claimed subject matter and cancel dependent claim 2 without prejudice. Further, Applicants add new claims 32-34, as discussed below. Upon entry of the amendments, claims 1, 4, 6, 27, and 31-34 will remain pending in the present patent application. Applicants respectfully request reconsideration of the above-referenced application in view of the foregoing amendments and the following remarks.

**Improper Finality of Office Action**

Applicants respectfully point out that the finality of this Office Action is premature. In the previous Office Action dated December 21, 2005, the Examiner rejected claims 1, 2, 6, and 27, and objected to claims 3, 4, and 30 for depending from a rejected base claim, but indicated that claims 3, 4, and 30 each contain allowable subject matter. *See* Office Action mailed December 21, 2005, page 4. In response to that Office Action, Applicants placed the application in condition for allowance. *See* Response to Office Action filed February 17, 2006, page 4. However, the present Office Action withdrew the previous indication of allowable subject matter and instituted a *new ground of rejection based on a new reference*. *See* Office Action mailed March 29, 2006, page 2. Applicants respectfully note that M.P.E.P. § 706.07(a) recites:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Applicants respectfully note that the new ground of rejection provided in the Office Action mailed March 29, 2006, was neither necessitated by Applicants' amendments to the claims nor based on information submitted in an information disclosure statement. Thus, in view of the M.P.E.P. § 706.07(a), the finality of this rejection is clearly premature. Accordingly, Applicants respectfully request withdrawal of the premature finality of the recent Office Action and entry of the present amendments.

### **Rejections Under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1, 4, 6, and 31 under 35 U.S.C. § 102(e) as anticipated by Kingon et al. (U.S. Patent No. 6,541,137). Applicants respectfully traverse this rejection.

### ***Legal Precedent***

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Moreover, the prior art reference also must show the *identical* invention "*in as complete detail as contained in the ... claim*" to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

### ***Omitted Features of Independent Claims 1 and 31***

Turning now to the present claims, the Kingon et al. reference fails to disclose each element of independent claims 1 and 31. Applicants respectfully note that independent claim 1 has been amended by the present Response to incorporate the subject matter of claim 2, and that the Office Action indicated this combination to be allowable

over the prior art of record. Consequently, Applicants respectfully request withdrawal of the instant rejection and allowance of independent claim 1 and its dependent claims 4 and 6.

With respect to independent claim 31, Applicants respectfully note that this claim, as amended, recites “an electroless nickel alloy layer disposed over *and directly in contact with* the metallic substrate” (emphasis added). Amended claim 31 also recites “an outer electrolytic nickel layer disposed over *and directly in contact with* the electroless nickel alloy layer” (emphasis added). Because the Kingon et al. reference fails to disclose both of these elements, the cited reference fails to anticipate independent claim 31.

As will be appreciated by the Examiner, the Kingon et al. reference generally teaches a multi-layer conductor-dielectric oxide foil suitable for making capacitors for circuit boards of electronic devices. *See* col. 1, lines 10-12. The cited reference teaches a multi-layer foil 10 having a barrier layer 12 disposed over a conductive metal layer 18. Col. 2, lines 59-62; FIG. 3. The foil 10 also includes a dielectric oxide layer 20 disposed over the barrier layer 12, a second barrier layer 21 disposed over the dielectric oxide layer 20, and a second conductive metal layer 22 disposed over the second barrier layer 21. Col. 2, lines 62-65; col. 3, lines 62-67. The reference also notes that an etch-resist layer 26 may be applied over the foil 10, and a polymer 28 may be applied to the foil 10 following an etching process. *See* col. 4, lines 11-20.

In the Office Action, the Examiner equated conductive metal layer 18 of the Kingon et al. reference with the recited “metallic substrate,” barrier layer 12 with the recited “electroless nickel alloy layer,” and second conductive metal layer 22 with the recited “outer electrolytic nickel layer.” As noted above, independent claim 31, as amended, recites that the outer electrolytic nickel layer is “directly in contact with the electroless nickel alloy layer.” Applicants respectfully note that layers 12 and 22 of the Kingon et al. reference (which the Examiner equated with the recited electroless nickel

alloy layer and the outer electrolytic nickel layer, respectively) are not in direct contact with one another. Consequently, these two layers cannot be logically equated with the recited electroless nickel alloy and outer electrolytic nickel layers.

Applicants also note that, with respect to some embodiments, Kingon et al. disclose that second conductive metal layer 22 is directly in contact with a second barrier layer 21. However, even assuming, for the sake of argument, that second barrier layer 21 could be considered an electroless nickel alloy layer, it is clear that this second barrier layer 21 is not “directly in contact with the metallic substrate,” as recited by the instant claim. In short, the Kingon et al. reference simply fails to disclose any structure that is reasonably comparable to both the electroless nickel alloy layer and the outer electrolytic nickel layer of independent claim 31. Accordingly, the Kingon et al. reference fails to disclose each and every element and, therefore, fails to anticipate independent claim 31.

For at least these reasons, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102 and allowance of claims 1, 4, 6, and 31.

### **New Claims**

New claims 32-34 have been added by this Response. These new claims add no new matter and are fully supported throughout the specification. Furthermore, in view of the earlier cancellation of claims 2, 3, 5, 7-26, and 28-30, which included three independent claims, no fees are believed due for the addition of claims 32-34 in this Response. Applicants respectfully note that these claims variously employ the transitional phrase “consisting essentially of” with respect to the claimed apparatus or the layers thereof. As noted above, the Kingon et al. reference is directed to a foil for making capacitors. As will be appreciated, this requires the inclusion of the dielectric oxide layer 20 as a necessary and essential component of the Kingon et al. foil. This dielectric oxide layer is inconsistent with the recitations of claims 32-34. As such, claims 32-34 are

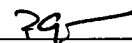
patentable over the cited references and are believed to be in condition for allowance.  
Accordingly, Applicants respectfully request allowance of claims 32-34.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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